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EXAMINER

WARD, RONALD J

ART UNIT

PAPER NUMBER

2685

DATE MAILED: 11/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. 09/406,321 | Applicant(s) SCHUSTER ET AL. |
|------------------------------|-------------------------------|---------------------------------|
| Examiner Ronald J Ward | Art Unit 2685 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 05 November 2002 .

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-7 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-7 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). _____ .
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 16, 17, 18 . 6) Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. **Claim 7** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In **claim 7**, the recitation, “locating a callee gateway closest to the user telephone number,” is unclear since the dimensional units of the objects of the comparison are incompatible. That is, the first unit of measure is “closeness” implied by the word “closest” which would logically be in meters or miles while the second unit of measure is a telephone number, which does not lend itself easily to any form of measurement. Therefore, it is not clear how one would conduct a measurement of closeness to a telephone number. The examiner suggests substituting the word --callee telephone-- for the phrase “user telephone number” on lines 2-3 of claim 7, to clarify the apparent intent of this claim.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1 and 3** are rejected under 35 U.S.C. 103(a) as being unpatentable over Jordan et al. (U.S. Patent Number 4313035) in view of Pepper et al. (U.S. Patent Number 5930700).

As to **claim 1**, Jordan discloses, in Figure 1, a personal information device used for controlling telephone service, referred to as a subscriber station (10). The subscriber station comprises:

a user interface comprising a user input device (inherent to any information device with two-way communications capability)

a user profile having a telephone number entered by a user (see Word 2 in Figure 5, see col. 5 line 58 through col. 6 line 4, see col. 10 lines 58-68)

a communications function to establish a data communications channel (22, 24, 26) over a network to a telephony control server (24, 25, 26, 27), the telephony control server containing the user's telephony account; (see col. 5 lines 58-61)

an account update function to send a message over the data communication channel to the telephony control server, the message containing the user profile telephone number (see col. 10 lines 58-68).

However, Jordan fails to explicitly recite a user interface comprising a display and that the communications network is wireless. Jordan does disclose an embodiment in which the personal information device is a wireless pager (see col. 12 line 58 through col. 13 line 3).

In an analogous art, Pepper, discloses, in Figure 3, a personal information device (200) comprising a user interface with a display (see col. 2 lines 41-51) and that establishes a data communications channel over a wireless network (see col. 1 lines 50-64) to a telephony control server (306, 308) containing the user's telephony account (see col. 9 lines 20-30, lines 58-60).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Jordan's personal information device to include a display and be adapted for

use in a wireless network, as taught by Pepper. One of ordinary skill in the art would have been led to make this modification because a display enhances the user's interface capabilities and flexibility of user control, and a wireless network allows subscribers to be mobile while using the services.

As to **claim 3**, Jordan discloses a telephony control server, referred to as a CCIS system (24, 25, 26, 27) in Figure 1. The server comprises:

a network interface operable to provide data connectivity with a user accessible via a network (see col. 5 lines 16-23);

an accounts program to access a plurality of user accounts (see col. 5 lines 58-63), the accounts program operable to receive a message to set a user telephone number, each user account containing a telephone number entry (see Word 2 in Figure 5), the accounts program being operable to set the telephone number entry in response to the message (see col. 10 lines 58-68);

a connection signaling function to receive a call message from the user and to establish a telephone connection between the user telephone number (11) and a callee telephone number contained in the message (see col. 7 line 39 through col. 8 line 42, wherein the user is caller B);

the connection signaling function operable to initiate a telephone call having at least a portion of the telephone call connected via the data network (see col. 7 lines 44-53).

However, Jordan fails to explicitly recite that the network is wireless.

In an analogous art, Pepper, discloses, in Figure 3, a telephony control server (306, 308) that comprises a network interface operable to provide data connectivity with a user accessible via a wireless network (see col. 5 lines 27-34).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Jordan's telephony control server to be adapted for use in a wireless network, as taught by Pepper. One of ordinary skill in the art would have been led to make this modification because a wireless network allows subscribers to be mobile while using the services.

5. **Claim 2** is rejected under 35 U.S.C. 103(a) as being unpatentable over Jordan in view of Pepper as applied to claim 1 above, and further in view of Moon et al. (U.S. Patent Number 6,075,992).

The combination system of Jordan and Pepper discloses everything as applied to claim 1 above. However, Jordan fails to explicitly recite that the personal information device comprises a contacts application operable to display and call a plurality of contact entries.

In an analogous art, Moon et al. discloses, in Figure 4, a portable intelligent device having a contacts application operable to display a plurality of contact entries, each entry comprising a contact telephone number (64, 66, 68), the contacts application operable to send the contact telephone number over the data communications channel to the telephony control server with a message to call (78) the contact telephone number (see col. 5 lines 35-58).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination device of Jordan and Pepper to be operable to display the plurality of contact entries stored in the device, as taught by Moon. One of ordinary skill in the art would have been led to make this modification because such personal information managers are well known in the art (see col. 4 line 67 through col. 5 lines 1-3 in Moon et al.).

6. **Claim 4** is rejected under 35 U.S.C. 103(a) as being unpatentable over Jordan and Pepper as applied to claim 3 above, and further in view of Wiedeman et al. (U.S. Patent Number 5,448,623).

The combination of Jordan and Pepper disclose everything claimed as applied to claim 3 above, but fail to explicitly recite the telephony control server having a gateway locator function to locate a user gateway closest to the user telephone and to locate a callee gateway closest to the callee telephone. Jordan does recite that reducing the length of a telephone connection is advantageous because it reduces transmission loss, signal distortion, echo, setup time, and number of facilities (see col. 2 lines 41-62).

In an analogous art, Wiedeman et al discloses a wireless telephone system having a network coordinating gateway, which “selects an Active Gateway, which will handle all calls to and from the user by a system selected method (such as gateway closest to user)” (see col. 6 lines 25-29). Thus, the network coordinating gateway inherently has a gateway locator to locate a user gateway closest to the user telephone and to locate a callee gateway closest to the callee telephone, wherein its connection signaling function initiates a connection between the user gateway and the callee gateway.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the telephony control server of Jordan to further comprise a gateway locator as described by Wiedeman et al. One of ordinary skill in the art would have been led to make this modification in order to reduce transmission loss, signal distortion, echo, setup time, and the number of facilities, as taught by Jordan.

7. **Claim 5** is rejected under 35 U.S.C. 103(a) as being unpatentable over Jordan and Pepper, and further in view of Moon et al.

Jordan discloses a method for modifying a user telephone account having a telephone number entry using a personal information device (PID) connected over a data network, the method comprising the steps of:

sending a request to set up the user telephone account to the user telephone number over a data communications channel to a telephony control server wherein the telephony control server updates the user telephone number entry to the user telephone number (see col. 10 lines 58-68).

However, Jordan fails to explicitly recite applying the method to a wireless network and updating a user profile in the wireless PID to a user telephone number. However, Jordan discloses updating a user profile in the telephony control server to the user telephone number (see col. 10 lines 58-68).

In an analogous art, Pepper, discloses, in Figure 3, a telephony control server (306, 308) that comprises a network interface operable to provide data connectivity with a user accessible via a wireless network (see col. 5 lines 27-34). Pepper also discloses updating a user profile in the wireless PID to a user telephone number (see col. 4 line 62 through col. 5 line 5).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Jordan's method to be adapted for use in a wireless network and to update a user profile in the PID, as taught by Pepper. One of ordinary skill in the art would have been led to modify the method for use in a wireless network because a wireless network allows subscribers to be mobile while using the services. One of ordinary skill in the art would have

been led to include the step of updating a user profile in the PID and not just the telephony control server because it allows the user to make an easily accessible record of the telephone number.

8. **Claim 6** is rejected under 35 U.S.C. 103(a) as being unpatentable over Jordan and Pepper, and further in view of Moon et al.

Jordan discloses a method for initiating a data network telephone call using a PID comprising the steps of:

initiating a data communications channel to a telephony control server having a user telephone number (see col. 10 lines 23-30, wherein the user telephone number is subscriber A's);
sending a message to call the callee (see col. 10 lines 28-30);
connecting a telephone call to the user; and
connecting a telephone call to the callee (see col. 10 lines 30-57)

However, Jordan fails to explicitly disclose that the PID is wireless and has a display. Also, Jordan fails to explicitly recite starting a contacts application to display a plurality of contact entries and selecting one of the contact entries identifying a callee.

In an analogous art, Pepper, discloses, in Figure 3, a personal information device (200) comprising a display (see col. 2 lines 41-51) and that establishes a data communications channel over a wireless network (see col. 1 lines 50-64).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Jordan's PID to include a display and be adapted for use in a wireless network, as taught by Pepper. One of ordinary skill in the art would have been led to make this

modification because a display enhances the user's interface capabilities and flexibility of user control, and a wireless network allows subscribers to be mobile while using the services.

In another analogous art, Moon discloses, in Figure 4, starting a contacts application to display a plurality of contact entries and selecting one of the contact entries identifying a callee (see col. 5 lines 7-58).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination device of Jordan and Pepper to start a contacts application to display a plurality of contact entries and select one of the contact entries identifying a callee, as taught by Moon. One of ordinary skill in the art would have been led to make this modification because such personal information managers are well known in the art (see col. 4 line 67 through col. 5 lines 1-3 in Moon et al.).

9. **Claim 7**, is rejected under 35 U.S.C. 103(a) as being unpatentable over Jordan, Pepper and Moon et al, and further in view of Wiedeman et al.

The combination of Jordan, Pepper, and Moon et al. disclose everything claimed as applied to claim 6 above. In addition Jordan discloses, in Figure 1, sending a signal to call the callee by dialing via a callee's central office (80) (see col. 10 lines 48-57).

However, Jordan, Pepper and Moon fail to explicitly recite the step of locating a callee gateway closest to the user telephone number.

In an analogous art, Wiedeman et al discloses a wireless telephone system having a network coordinating gateway, which "selects an Active Gateway, which will handle all calls to and from the user by a system selected method (such as gateway closest to user)" (see col. 6 lines 25-29).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of the combined system of Jordan, Pepper, and Moon to include the step of locating a callee gateway closest to the callee telephone, as described by Wiedeman et al. One of ordinary skill in the art would have been led to make this modification in order to reduce transmission loss, signal distortion, echo, setup time, and the number of facilities, as taught by Jordan.

Response to Arguments

10. Applicant's arguments with respect to **claims 1-7** have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ronald J. Ward whose telephone number is (703) 305-5616. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Urban, can be reached at (703) 305-4385.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 2600 Customer Service Office at (703) 306-0377.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872-9314 (Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington, VA., Sixth Floor (Receptionist).

RJW 
November 15, 2002


11/16/02
LESTER G. KINCAID
PRIMARY EXAMINER